

## REMARKS

In accordance with the foregoing, Claim 35 has been added. Claims 18-35 are pending and under consideration.

The following are the remarks made on May 13, 2003, which should be considered with the above new claim.

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In the Final Office Action mailed on January 13, 2003, claims 18, 21-22, 25-29, 31, and 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soliman (U.S. Patent No. 6,101,179) ("Soliman") in view of Trandai et al. (U.S. Patent No. 5,893,036) ("Trandai"); claims 19-20 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soliman in view of Trandai and further in view of Olofsson et al. (U.S. Patent No. 6,157,627) ("Olofsson"); claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Soliman in view of Trandai and further in view of Langlet et al. (U.S. Patent No. 5,930,248) ("Langlet"); claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Soliman in view of Trandai and further in view of Mallinckrodt (U.S. Patent No. 5,878,329) ("Mallinckrodt"). The foregoing rejections are respectfully traversed.

Claims 18-22 and 24-34 are pending in the subject application, of which claims 18, 33, and 34 are independent.

In the Amendment filed on October 30, 2002, the Applicants argued that the rejections under § 103(a) were improper because the Examiner did not adequately set forth the required motivation to combine the references (10-30-2002 Amendment, p. 3-5). In response thereto, the Examiner stated that he relies on the part of Trandai "teaching the mobile station determines from Broadcast Control Channel signal by a base station and the mobile station transmits a Random Access Channel signal to initiate the call, but [does] not [rely] on other features of Trandai" (Final Office Action, p. 6, item 8). Unfortunately, the statement in the Final Office Action does not cure the defects in the § 103(a) rejections.

### **Lack of Motivation to Combine the Cited References:**

The Examiner has failed to set forth the required motivation to combine the references.

**Legal Standard:**

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

**No Evidence Presented:**

The Examiner has not presented any evidence why any of Soliman and Trandai would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The Examiner does not even attempt to support such a combination, stating only that it would have been obvious "to modify the system of Soliman with the above teaching of trandai et al. in order to provide an initial transmission power control is chosen by the base station based on factors such as cell configuration, cell size and interference levels and offering random access which can be received requests from all mobile stations" (Final Office Action, p. 3) (errors in original). The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references or in any other prior art, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and

unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

**Soliman and Trandai Teach Away From One Another:**

In addition to the remarks set forth above, the combination is improper because Soliman and Trandai cannot be combined.

Soliman deals with a CDMA system, while Trandai deals with a GSM system. The present invention is about power control; Soliman (cols. 1-2) discusses that power control is the most important thing for communication in CDMA systems, in fact, "power" is the resource that is divided between different mobile stations in CDMA systems. In contrast, in GSM systems, "time slots" are the resource that is divided between mobile stations. Therefore, calculating the transmission power for random access is something essential for CDMA (see Soliman, col. 2). However, in GSM systems, each mobile station uses its own time slot, so that the amount of transmission power applied by a mobile station does not interfere with transmission power of other mobile stations. In fact, Trandai discusses that transmission power is important because the battery of the mobile station is spared (Trandai, col. 1, lines 57-58).

As argued, transmission power adjusting plays a rather contrary role in these two systems. In fact, an expert in the field of radio communication, having the task of finding a method of connection setup in a system with recurrently offered frequency channels for random access, would never start with the CDMA system of Soliman and modify it using the system of Trandai as the Examiner suggests.

Therefore, the modification to Soliman that the Examiner proposes is supported only by unacceptable hindsight. Soliman uses a system that is completely different from the one described in, for example, claim 18, and adds the features, which the Examiner borrows from a GSM system, without there being any connection between the added features taken from the GSM and the CDMA systems. There is no suggestion or motivation in either reference or in the general knowledge of those skilled in the art at the time of the invention to modify Soliman using Trandai.

In addition, Trandai discusses the power control of mobile stations seeking access to a cellular communication system. In the communication system discussed in Trandai, the base station controls the transmission power level of a mobile station (Trandai, col. 1, lines 10-12).

The base station broadcasts a power step command on a Broadcast Control Channel (BCCH) signal that is received by compatible mobile stations in its coverage area before any access attempt is made by a mobile station (Trandai, col. 1, lines 20-23). Thus, when a portable telephone or other mobile station tries to contact the base station using a Random Access Channel (RACH) signal, it has instructions on which power step to use to initiate and maintain contact (Trandai, col. 1, lines 23-27). Then, the mobile station transmits a RACH signal at the power level corresponding to the power step broadcasted by the base station (Trandai, col. 3, lines 6-10 and 16-18).

In contrast, Soliman discusses a method for open loop power control in which the mobile station determines the power value applied for the initial access probe (Soliman, col. 4, lines 19-26). This is achieved by measuring the forward link path loss of a pilot channel, knowing the power level of the pilot channel (Soliman, col. 4, lines 34-36). The base station does not prescribe any power value for the initial access probe, it merely transmits the pilot channel (Soliman, col. 4, lines 26-28).

Clearly, Trandai and Soliman cannot be combined. Their content is contrary to each other; specifically, in Soliman, the mobile station measures, calculates, and determines an apt power value, while in Trandai, the base station prescribes and the mobile station obliges. Impermissible hindsight would be required to modify use of the broadcast channel of Trandai, applied by the base station of Trandai to command the power value to instead supply a signal that the mobile station measures and to determine the power value as in Soliman.

Therefore, claims 18, 33, and 34 of the present invention patentably distinguish over Soliman and Trandai. Claims 19-22 and 24-32 are allowable based in part on their dependency, directly or indirectly, from one of allowable claims 18, 33, and 34.

Withdrawal of the foregoing rejections is respectfully requested.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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